

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated March 9, 2009. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-9 and 11-17 are pending in the Application.

By means of the present amendment, the claims are amended to place the claims back into a form provided as originally submitted. The amendment provided in the Amendment submitted on December 3, 2008 was an attempt to simplify the claim language and is believed supported by the application as filed. However, apparently, the Office Action has taken a position that such language is not supported by the specification as filed. While this position is traversed below, the Applicants have elected to amend the claims to expedite consideration and allowance of the claims. The amendment to the claims is not intended to narrow the scope of the prior claims and is merely submitted to further prosecution of this matter and to either promote allowance of the claims or at least and reduce pending issues for appeal. Clearly, no new matter is added by these amendments as the claims as amended are put back

into the form as originally submitted. Entrance and consideration of the amended claims is respectfully requested.

By these amendments, the claims are not amended to address issues of patentability and Applicants respectfully reserve all rights under the Doctrine of Equivalents. Applicants furthermore reserve the right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or continuing applications.

ELECTION/RESTRICTIONS ARE IMPROPER

In the Official Action, it is alleged that "[n]ewly submitted claims 11-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The inventions as claimed are independent since they are not connected in design, operation or effect, i.e., each invention is separately usable and the operation, design and effect of one is independent of the other.."

This position provided in the Office Action is respectfully traversed. It is respectfully submitted that claims 1-9 and claims 11-17 are connected as claims 1-9 are drafted as "means plus function claims" while claims 11-17 are drafted to structural

elements that correspond to some of the structure provided in the application in support of the means plus function elements of claims 1-9.

For example, claim 1 recites "means for guiding the heated water from said one or more holes to outside the device without contacting said upper wall ..." while claim 11 recites the structural limitation of "one or more tubes configured to guide the heated liquid water from the one or more holes to outside the device without contacting the upper wall ..."

Clearly, claims 1 and 9 are connected in at least "effect" of guiding the heated liquid water from the one or more holes to outside the device without contacting the upper wall and accordingly, restriction therebetween is improper.

It is Applicants' position that in fact each of claims 1-9 and 11-17 are drawn essentially to a single embodiment (see, FIG. 4 of the present patent application).

The MPEP in § 806.03 makes clear that (emphasis provided) "[w]here the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required." The MPEP goes on further to state the motivation for the above requirement is

"because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition."

The MPEP in §803 makes clear that a restriction between patentably distinct inventions is only proper if the inventions are independent or distinct as claimed and there is a serious burden on the examiner if a restriction is not required. A serious burden on the examiner is *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search (see, further MPEP §808.02). However, where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." Yet, the Office Action has done no more than to state that they are independent and distinct without any suitable showing or explanation for this distinction.

Further, MPEP 801.01 in a section entitled "Reasons for Holding of Independence or Distinctness" makes clear that (emphasis added) "[t]he particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or

distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given."

However, in the Office Action, no such reasons are provided other than the general statement that the claims are independent and distinct together with a recitation of a form paragraph. It is respectfully submitted that the restriction requirement provides no basis for that position and in fact, such a position finds no basis in the claims as provided.

Accordingly, it is respectfully requested that the restriction requirement be withdrawn and that claims 11-17 be examined on the merits. In the event that this restriction requirement is upheld, it is respectfully requested that it be restated in a further Office Action with support for the requirement so that the Applicants may consider and address that support in a subsequent response.

THE REJECTION OF CLAIMS 1-9 UNDER 35 U.S.C. §112, FIRST PARAGRAPH IS OBLIVIATED

Claims 1-9 are rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description

requirement. This rejection of claims 1-9 is respectfully traversed. However, in the interest of advancing consideration and allowance of the claims, the Applicants have elected to amend the claims as referenced above to place the claims in the form as originally submitted. It is respectfully submitted that these amendments to the claims obviates this rejection under 35 U.S.C. §112, first paragraph. Accordingly, it is respectfully requested that this rejection of claims 1-9 under 35 U.S.C. §112, first paragraph, be withdrawn.

CLAIMS 1-9 ARE PATENTABLE OVER EITHER OF KRAAN AND ILLY

In the Office Action, claims 1-9 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by European Patent Publication No. WO 01/15582 to Kraan ("Kraan") and European Patent Publication No. WO 97/43937 to Illy ("Illy"). The rejection of claims 1-9 is respectfully traversed. It is respectfully submitted that claims 1-9 and 11-17 are allowable over Kraan and Illy for at least the following reasons.

The Office Action takes a position that "[w]hile features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the

prior art in terms of structure rather than function." While this is a true statement of the relevant patent law, what is ignored by the Office Action is that claims 1-9 are drawn as means plus function claims.

35 U.S.C. §112, sixth paragraph states that (emphasis added) "[a]n element in a claim for a combination may be expressed as a means ... for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Accordingly, as made clear, a means plus function claim is proper and the Office Action is not free to ignore the functional limitation stated within the claims as apparently done in this instance.

The MPEP in §2181 identifies a "3-prong analysis" for determining whether a claim invokes 35 U.S.C. §112, sixth paragraph which analysis includes:

(A) the claim limitations must use the phrase "means for" or "step for;"

(B) the "means for" or "step for" must be modified by functional language; and

(C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

With regard to the first prong of the above test, claim 1 recites "means for ..." and as such, the first prong of the test is met by claims 1-9.

With regard to the second prong of the above test, claim 1 recites the functional language "for guiding the heated water from said one or more holes to outside the device without contacting said upper wall ..." and as such, the second prong of the test is met by claims 1-9. Apparently, this prong is undisputed since the Office Action has taken a position that (emphasis added) "claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" which seems an implicit acknowledgement that the claims contain such functional language.

With regard to the third prong of the above test, claim 1 does not recite "structure, material, or acts for achieving the specified function ..." and as such, the third prong of the test is met by claims 1-9.

Accordingly, it is respectfully submitted that since claims 1-9 clearly meet each of the requirements of the "3-prong analysis",

clearly the claims should be interpreted under 35 U.S.C. §112, sixth paragraph and the functional limitations recited in the claims should be considered in making a proper consideration of patentability.

MPEP §2181 makes clear that (emphasis added) "[w]here a claim limitation meets the 3-prong analysis and is being treated under 35 U.S.C. 112, sixth paragraph, the examiner will include a statement in the Office action that the claim limitation is being treated under 35 U.S.C. 112, sixth paragraph." Yet the Office Action contains no such statement and therefore, the Rejection of claims 1-9 is improper.

MPEP §2181 further makes clear that (emphasis added) "[i]f a claim limitation does include the phrase 'means for' ..." that is, the first prong of the 3-prong analysis is met, but the examiner determines that either the second prong or the third prong of the 3-prong analysis is not met, then in these situations, the examiner must include a statement in the Office action explaining the reasons why a claim limitation which uses the phrase "means for" or "step for" is not being treated under 35 U.S.C. 112, sixth paragraph."

It is respectfully submitted that claims 1-9 clearly meet the first prong of the 3-prong analysis yet, no such statement of why the claims were not treated under 35 U.S.C. 112, sixth paragraph is provided by the Office Action. Accordingly, it is respectfully submitted that the Office Action is improper for this additional reason. Accordingly, should this rejection be maintained, it is respectfully requested that it be maintained in a further Office Action to provide the Applicants and opportunity to respond to any issues raised therein.

While the Office Action alleges that "[t]he structural features of the instantly rejected claims appear to be structurally met by the either one of the references." This position is respectfully traversed. Neither of Kraan and Illy have structure that corresponds to the limitation recited in the claims.

Kraan shows an apparatus for preparing coffee including "a holder 4 detachably connected to the housing. The holder 4 is arranged for receiving a pouch 6, made of a filter material and filled with a product to be extracted, such as ground coffee ..." (See, Kraan, FIG. 1 and the accompanying description contained on page 5, lines 8-11.) Kraan makes clear that "[t]he holder 4 is of cup-shaped design and consists of a bottom 16 and an upright,

circumferential side wall 18, connected to the bottom. Provided in the bottom 16 is a recess 20, provided with at least one outflow opening 22. At its upper end, the holder is provided with an access opening 24." (See, Kraan, page 5, lines 16-19.) The device includes "a liquid duct 40" for conducting heated water through an inflow opening 38 to the outflow opening 24 (see, Kraan, page 6, lines 1-4). As is clear from even a cursory review of Kraan, heated water exiting the inflow opening 38, the outflow opening 24 and outflow opening 22 is free to contact surface portions of corresponding elements prior to entering any of the inflow opening 38, the outflow opening 24 and outflow opening 22.

Illy, shows an adapter 1 including an aperture 5 at its center that allows hot water to pass from an upper part 13 of a percolating chamber to a lower part 10 of the percolating chamber (see, Illy, FIGS. 1, 2 and the accompanying description contained in page 3, lines 19-23 and page 4, lines 4-12). Similar as Kraan, Illy, as is clear from even a cursory review, allows heated water passing the aperture 5 to freely contact surface portions of both the upper and lower parts 13, 10 of the percolating chamber.

Accordingly, it is respectfully submitted that the device of claim 1 is not anticipated or made obvious by the teachings of

Kraan and Illy. For example, Kraan and Illy do not teach, disclose or suggest, a device that amongst other patentable elements, comprises (illustrative emphasis added) "a brewing chamber, the brewing chamber being defined by an upper wall with one or more holes through which heated water can enter the brewing chamber, and by a wall of a first removable part having an edge that can abut against said upper wall via first sealing means to form the brewing chamber, said first removable part being provided with outlet means for guiding the brewed liquid out of the brewing chamber, and a second removable part comprising means for guiding the heated water from said one or more holes to outside the device without contacting said upper wall, which second removable part is interchangeable with said first removable part" as recited in claim 1, and as similarly recited in each of claims 9 and 11. As should be clear from the discussion above, clearly the structural features of claims 1, 9 and 11 or those properly functionally claimed under 35 U.S.C. §112, sixth paragraph, are not structurally met by the either one of Kraan and Illy.

Based on the foregoing, the Applicants respectfully submit that independent claims 1, 9 and 11 are patentable over Kraan and Illy and notice to this effect is earnestly solicited. Claims 2-8

and 12-17 respectively depend from one of claims 1 and 11 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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June 9, 2009

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